REMARKS

Claims 1-7, 15, 16, 18-24, 32, 34, and 35 are pending in the present application. Claims
8-14, 17, 25-31, and 33 were previously canceled in response to restriction requirement dated
June 21, 2005. Claims 1, 3, 15, 18, 20, and 32 are amended. Claims 34 and 35 are added.
Reconsideration of the claims is respectfully requested.

I.   Telephone Interview with Examiner Kyle on October 19, 2005

Applicants thank Examiner Kyle for the courtesy extended to Applicants' representative
during the October 19, 2005 telephone interview. During the teleconference, the Examiner and
Applicants' representative discussed a proposed independent claim amendment and the cited
prior art. The Examiner did indicate during the teleconference that the proposed independent
claim amendment may overcome the cited prior art. However, the Examiner also stated that he
will perform another prior art search.

II.   35 U.S.C. § 103, Obviousness

The Examiner has rejected claims 1-7, 15, 16, 18-24, and 32 under 35 U.S.C. § 103 as
being unpatentable over Stinson et al., U.S. Patent No. 6,786,398 ("Stinson") in view of
Anderson et al., U.S. Patent No. 6,021,202 ("Anderson"). This rejection is respectfully
traversed.

The Examiner bears the burden of establishing a *prima facie* case of obviousness based
on the prior art when rejecting claims under 35 U.S.C. § 103. *In re Fritch*, 972 F.2d 1260, 23
U.S.P.Q.2d 1780 (Fed. Cir. 1992). For an invention to be prima facie obvious, the prior art must
teach or suggest all claim limitations. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).
The Examiner has not met this burden because all of the features of these claims are not found in
the cited references as believed by the Examiner. Therefore, the combination of Stinson and
Anderson would not reach the presently claimed invention recited in these claims.

Amended independent claim 1 of the present invention, which is representative of amended
independent claims 15, 18, and 32, reads as follows:

1.   A method in a data processing system for processing a check in an
automatic teller machine, the method comprising:

receiving a check in the automatic teller machine;

scanning the check within the automatic teller machine to generate an image;

performing optical character recognition on the image to generate data; and

creating a markup language representation of the check using the data, wherein the markup language representation of the check includes a signed document markup language.

With regard to claim 1, the Examiner states:

As to claim 1, *Stinson* discloses the invention substantially as claimed, including in a method in a data processing system for processing a check in an automatic teller machine (Fig. 6A; Col. 5, lines 23-26), steps of:
receiving a check in the automatic teller machine (Col. 7, lines 46-48);
scanning the check within the automatic teller machine to generate an image (Col. 7, lines 48-53);
performing optical character recognition on the image to generate data; and
creating a electronic representation of the data (Col. 9, lines 49-62).

Stinson does not specifically disclose that the check data is used to produce a markup language representation of the check. *Andrerson* discloses this limitation at Abstract, Summary of the Invention and Col. 18, line 63 to Col. 19, line 43. Note that *Andrerson* further discloses scanning and optical character recognition of checks at Col. 28, line 58 to Col. 29, line 10 and that the invention works in the ATM environment at Col. 14, lines 23-27. These features map to those *Stinson*. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Stinson* to include the markup language representation of check data disclosed by *Andrerson* because this would provide advantages specifically set out by *Andrerson* at Col. 14, lines 23-27....

Office Action, dated July 26, 2005, pages 2 and 3.

Stinson teaches a method for check-cashing in an automated check-cashing unit, which includes an input device configured to generated input signals in response to inputs from a customer, a storage device including a database of customer information, a check reader configured to receive and read a check to be processed, a cash dispenser, and an electronic processor. Stinson, abstract. Even though Stinson teaches a method for check-cashing in an automated check-cashing unit which includes a scanner for producing an image of the check, Stinson does not teach or suggest creating a markup language representation of the check. Further, Applicants agree with the Examiner that, "Stinson does not specifically disclose that the check data is used to produce a markup language representation of the check." Office Action, page 2.

In contrast, as amended, claim 1 of the present invention recites creating a markup language representation of the check. In addition, because Stinson does not teach or suggest creating a markup language representation of the check, Stinson cannot teach or suggest that the markup language includes a signed document markup language as further recited in amended claim 1. Support for this amendment may be found in the specification on page 16, line 10 – page 17, line 17. By way of example, signed document markup language is a markup language designed to tag individual text contained within a document and sign the individual text individually or together. The signatures become part of the signed document markup language document and may be verified by subsequent recipients as the document travels through the business process. Specification, page 17, lines 3-12. Therefore, Stinson does not teach or suggest the above features in claim 1.

Anderson fails to cure the deficiencies of Stinson. Anderson teaches a method for processing electronic documents that includes a markup language according to the standard generalized markup language in which document type definitions are created. Anderson, abstract. Also, Anderson teaches that one type of electronic document to be processed is an electronic check and that the electronic check may be formatted in financial services markup language. Anderson, column 18, lines 15 and 23. Even though Anderson teaches creating a markup language representation of the check, Anderson only teaches standard generalized markup language and financial services markup language. Anderson neither teaches, nor suggests the desirability of, creating a markup language representation that includes a signed document markup language as recited in amended claim 1. Hence, Anderson does not teach or suggest the above recited claim 1 limitation either.

Therefore, since neither Stinson nor Anderson teach or suggest creating a markup language representation of the check that includes a signed document markup language as recited in amended claim 1 of the present invention, then the combination of Stinson and Anderson cannot teach or suggest this recited feature. Accordingly, the rejection of amended independent claims 1, 15, 18, and 32 as being unpatentable over Stinson in view of Anderson has been overcome.

In view of the arguments above, amended independent claims 1, 15, 18, and 32 are in condition for allowance. As a result, claims 2-7 and 34 are dependent claims depending on independent claim 1. In addition, claims 19-24 and 35 are dependent claims depending on

independent claim 18. Consequently, claims 2-7, 19-24, 34, and 35 also are allowable, at least by virtue of their dependence on allowable claims. Furthermore, these dependent claims also contain additional features not taught by Stinson and Anderson.

For example, added dependent claim 34 of the present invention, which is representative of added dependent claim 35, reads as follows:

> 34.   The method of claim 1, further comprising:
> verifying a user of the automatic teller machine, wherein the user is verified using a smart card with a personal identification number, and wherein the smart card is programmed to self-destruct if the personal identification number is incorrectly inputted a predetermined number of times.

Stinson teaches that, "[t]he automated teller machine also may include a card reader, and the apparatus may be configured to perform banking transactions associated with an account identified by a card inserted into the card reader." Stinson, column 2, lines 52-55. In other words, Stinson teaches the use of an automated teller machine card in order to identify a bank account. However, Stinson makes no reference to utilizing a smart card that includes a personal identification number as recited in claim 34. Because Stinson does not teach or suggest using a smart card, Stinson cannot teach or suggest that the smart card is programmed to self-destruct if the personal identification number is incorrectly inputted a predetermined number of times as further recited in claim 34. Support for these claim 34 features may be found in the specification on page 14, lines 12-14. Therefore, Stinson does not teach or suggest the above claim 34 features.

Anderson teaches the use of smart cards, which are more versatile than simple credit cards, and are capable of exchanging data with a computer or automatic teller machine. Anderson, column 7, lines 51-56. Anderson also teaches that the smart card includes a personal identification number. Anderson, column 30, lines 65-67. Further, Anderson teaches a timeout mechanism to protect against fraudulent use of the smart card. Anderson, column 31, lines 1-6. However, even though Anderson teaches a smart card with a personal identification number and a timeout mechanism, Anderson does not teach or suggest programming the smart card to self-destruct if the personal identification number is incorrectly inputted a predetermined number of times as recited in claim 34. Consequently, Anderson does not teach or suggest this added claim 34 feature either.

Accordingly, the rejection of claims 1-7, 15, 16, 18-24, 32, 34, and 35 as being unpatentable over Stinson in view of Anderson has been overcome.
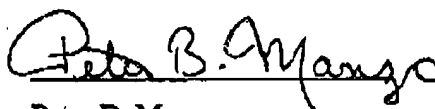
III.   Conclusion

It is respectfully urged that the subject application is patentable over the cited prior art references and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

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